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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,792	02/24/2004	Kishio Shibato	Q79832	2181
23373	7590	11/15/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,792	<b>Applicant(s)</b> SHIBATO ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/30/06 Amendment.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicants' amendment filed on August 30, 2006 is acknowledged. Claims 1-9 are deleted. Claims 10-11, 14 and 20-21 are amended. Now, Claims 10-21 are pending.
2. Claim objection(s) in the previous Office Action (Paper No. 052706) is/are removed.
3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 052706) is/are removed.
4. Claim rejection(s) under double patenting rejection in the previous Office Action (Paper No. 052706) is/are removed.
5. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

***Claim Rejections - 35 USC § 102***

6. Rejection of Claims 10-21 under 35 USC 102(b) as being unpatentable over Yamamoto (US 6 103 387) is maintained because the rejection is adequately set forth in paragraph 9 of Paper No. 052706. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 11, 2<sup>nd</sup> to 4<sup>th</sup> paragraphs), Examiner disagrees. Yamamoto does teach the compound B) can contain epoxy and hydroxy groups. (col. 10, lines 61 to col. 11, line 10) Furthermore, in another embodiment, component A) can be component A') (col. 25, lines 49-67) that is prepared by polymerizing a monomer mixture comprising a **hydroxy** containing monomer (col. 27, lines 5-17), an **epoxy** containing monomer (col. 28, lines 9-28), a **carboxyl** containing monomer (col. 27, lines 18-42), etc.

For Applicants' argument (Remarks, page 11, last paragraph to page 12, 2<sup>nd</sup> paragraph), Examiner disagrees because the polyvinyl ether does contain a blocked carboxyl group.

For Applicants' argument (Remarks, page 12, 3<sup>rd</sup> paragraph to page 13, 2<sup>nd</sup> paragraph), note that ingredient A') can contain an epoxy group. (col. 26, lines 1-8 and col. 28, lines 1-28)

For Applicants' argument (Remarks, page 13, 3<sup>rd</sup> to 4<sup>th</sup> paragraphs), Examiner disagrees because Applicants' component C) can be the same as Applicants' non-radical polymerizable organosilicate of formula (2) or any other types of organosilicate. Furthermore, Yamamoto discloses a component B) that can be either radical polymerizable organosilicate and/or non-radical polymerizable organosilicate. (col. 11, lines 47-61) The component B) having hydrolyzable groups can certainly react with the hydroxyl groups of the hydroxyl group-containing radical polymerizable monomer.

7. Rejection of Claims 10-21 under 35 USC 102(b) as being unpatentable over Nambu (EP 1 013 730/US 6 316 572) is maintained because the rejection is adequately set forth in paragraph 10 of Paper No. 052706. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 14, 4<sup>th</sup> paragraph to page 15, 5<sup>th</sup> paragraph), as mentioned in Paper No. 052706, Nambu is silent on polymerizing the mixture of compound x) and compound y) in the presence of component C). However, these claims are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of

Art Unit: 1712

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Note that the acrylic resin in Applicants’ comparative Example 3 is different from Nambu’s material. As such, it appears that Applicants’ alleged unexpected result is irrelevant.

8. Rejection of Claims 10-15 and 18-21 under 35 USC 102(b) as being unpatentable over JP847 (JP 11-116847) is maintained because the rejection is adequately set forth in paragraph 11 of Paper No. 052706. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants’ argument (Remarks, page 16, last two paragraphs), as mentioned in Paper No. 052706, JP847 is silent on the specific process of polymerizing the monomer mixture in the presence of component B). However, these claims are a product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its

Art Unit: 1712

method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Note that the acrylic resin in Applicants’ comparative Example 3 is different from JP847’s material. As such, it appears that Applicants’ alleged unexpected result is irrelevant.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

Art Unit: 1712

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Application/Control Number: 10/784,792

Page 8

Art Unit: 1712

klp

November 10, 2006

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712